

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL T. VANGOMPEL, GEORGIA L. ZEHNER,
THOMAS H. ROESSLER and YUNG H. HUANG

Appeal No. 98-1314
Application No. 08/421,640¹

ON BRIEF

Before MEISTER, PATE and McQUADE, ***Administrative Patent Judges***.

MEISTER, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, 4, 6-15, 17-22 and 25-41. Claims 5 and 24, the only other claims remaining in the application, stand withdrawn from

¹ Application for patent filed April 13, 1995.

Appeal No. 98-1314
Application No. 08/421,640

further consideration by the examiner under the provisions of
37 CFR

§ 1.142(b) as being directed to a nonelected species.

We AFFIRM-IN-PART.

The appellants' invention pertains to a fastening tab and
to an article having such a fastening tab. Independent claims
36 and 38 are further illustrative of the appealed subject
matter and copies thereof may be found in the appendix to the
brief.

The references relied on by the examiner are:

Krushel	4,773,906	Sep. 27,
1988		
Rossini et al. (Rossini)	5,312,387	May
17, 1994		
Flug et al. (Flug)	5,401,275	Mar. 28,
1995		

Claims 1, 2, 4, 6-9, 11-15, 17-22 and 25-41 stand
rejected under 35 U.S.C. § 103 as being unpatentable over
Krushnel in view of Rossini. According to the examiner:

Krushnel discloses the claimed invention except
for T-shaped tabs with a distal portion and an
inboard portion and requires the distal portion of
the securing means leading region having a length
dimension which is less than a length dimension of
the inboard portion of the securing means leading
region. It would have been an obvious matter of

Appeal No. 98-1314
Application No. 08/421,640

design choice to make the tabs T-shaped, since applicant has not disclosed that the use of a T-shape solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with rectangular tabs, additionally Rossini et al. disclose the use of T-shaped tabs.

. . . the [provision of a] T-shaped [tab] is merely a matter of engineering design choice, and thus does not serve to patentably distinguish the claimed invention over the prior art. See *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975). [Answer, page 5.]

Claims 1, 2, 4, 6-15, 17-22 and 25-41 stand rejected under 35 U.S.C. § 103 as being unpatentable over Flug in view of Rossini. According to the examiner:

Flug discloses the claimed invention except for T-shaped tabs with a distal portion and an inboard portion and requires the distal portion of the securing means leading region having a length dimension which is less than a length dimension of the inboard portion of the securing means leading region. It would have been an obvious matter of design choice to make the tabs T-shaped, since applicant has not disclosed that the use of a T-shape solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with rectangular tabs, additionally Rossini et al. disclose the use of T-shaped tabs.

. . . the [provision of a] T-shaped [tab] is merely a matter of engineering design choice, and thus does not serve to patentably distinguish the claimed invention over the prior art. See *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975). [Answer, pages 6 and 7.]

The arguments of the appellants and examiner in support of their respective positions may be found on pages 14-29 of the brief, pages 1-4 of the reply brief,² and pages 7 and 8 of the answer.

OPINION

Considering first the rejections under 35 U.S.C. § 103 of (a) claims 1, 2, 4, 6-9, 11-15, 17-22, 25-35, 37 and 38 as being unpatentable over Krushnel in view of Rossini and (b) claims 1, 2, 4, 6-15, 17-22, 25-35, 37 and 38 as being unpatentable over Flug in view of Rossini, the appellants vigorously contend that the provision of a (1) substantially T-shaped securing means leading region (independent claims 1, 21 and 37), (2) a substantially T-shaped securing means leading region with a narrowed medial region (dependent claim 17) and (3) a substantially T-shaped securing means with a

² In both the brief and reply brief, the appellants have relied on an unpublished Board opinion ("**Ex parte William Garrett**"). We must point out, however, that unpublished Board opinions are not binding as precedent (**Ex parte Holt**, 19 USPQ2d 1211, 1214 (Bd. Pat. App. & Int. 1991)) and citing such a decision as precedent is improper and inappropriate (**see Ex parte Vossen**, 155 USPQ 109, 110 (Bd. App. 1967)).

narrowed medial region (independent claim 38) cannot be dismissed as a matter of engineering design choice as the examiner has proposed with respect to each of these claims. The appellants, however, have presented no convincing argument or evidence that the particular configuration of the leading region of the securing means is in any way significant (**see, e.g., *In re Dailey***, 357 F.2d 669, 672-73, 149 USPQ 47, 50 (CCPA 1966)) or results in a fastener which performs and operates any differently than the prior art (**see, e.g., *Gardner v. TEC Systems, Inc.*** 725 F.2d 1338, 1349, 220 USPQ 777, 786 (Fed. Cir. 1984), **cert. denied**, 469 U.S. 830, 225 USPQ 232 (1984) and ***In re Troiel***, 274 F.2d 944, 948-49, 124 USPQ 502, 505 (CCPA 1960)). Indeed, the appellants do not even contest the examiner's position that rectangular tabs would "perform equally well" (answer, pages 5 and 6).

Instead of attaching any importance or criticality for the particular configuration of the leading region of the securing means, the specification merely states that this configuration "can be" substantially T-shaped (see, e.g.,

pages 6 and 32).³ The appellants reference page 3 of the specification as support for the notion that the specification establishes the particular configuration of the leading region of the securing means to be an "aspect" that contributes to the "distinctive advantages" afforded by the invention. Page 3, however, merely broadly refers to "various aspects" of invention providing advantages such as a "neat appearance," "dynamic fit," "improved fit," "improved securement with fewer pop-opens," "greater comfort," "reduced irritation," and "reduced irritation and reduced red marking of the wearer's skin." The referred to "various aspects" and the noted advantages, however, are immediately preceded by a description of the invention which makes no reference whatsoever to the substantially T-shaped configuration of the leading region of the securing means. Instead, this description of the invention concentrates on the fastening tab being provided

³ If the provision of the leading region of the securing means being "substantially T-shaped" and having a "narrowed medial region" were such a vital part of the appellants' invention, it seems strange to us that all mention of its **importance** was omitted from the original description. **See *Graham v. John Deere Co.***, 383 U.S. 1, 24-26, 148 USPQ 459, 469-470 (1966).

Appeal No. 98-1314
Application No. 08/421,640

with leading and trailing spaced-apart regions separated by a spacing section and a spacing distance. See also pages 7 and 8 of the specification which refers to various advantages being attributable to a "distinctive gap-interval sequential fastening," without making any reference whatsoever to the substantially T-shaped configuration of the leading region of the securing means. In our view, notwithstanding the nebulous reference to "various aspects" on page 3, the specification taken as a whole fails to provide a basis for concluding that the particular configuration of the leading region of the securing means (i.e., substantially T-shaped) is in any way significant or results in a fastener which performs and operates any differently than the prior art. Accordingly, we are of the opinion that the claimed configuration of the leading region of the securing means does not serve to patentably distinguish the claims under consideration over the arrangement of either Krushnel or Flug.

In the reply brief, the appellants argue that "the structures taught by Krushnel and Flug et al. cannot 'inherently' provide the peel strength and Gurley stiffness values called for by the particular claims of applicants" (see

page 2). This argument, at the most, is relevant to claims 11-15 and 30-34 since these are the only claims which set forth such values. Even with respect to these claims, however, the appellants have made no showing that the particular parameters recited therein are in any way critical or achieve an unexpected result. As the court stated in ***In re Woodruff***, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990):

Nor can patentability be found in the difference in . . . ranges recited in the claims. The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . . These cases have consistently held that in such a situation, the applicant must show that the particular range is ***critical***, generally by showing that the claimed range achieves unexpected results relative to the prior art range . . . (obviousness determination affirmed because dimensional limitations in claims did not specify a device which performed and operated differently from the prior art). . . . [Citations omitted.]

Contrary to establishing any criticality for the claimed range of Gurley force (claims 11-13 and claims 30-32) and the relative peel removal forces (claims 14, 15, 33 and 34), the specification merely states that (1) the spacing section "can have" a Gurley thickness within the claimed range (see page

37), (2) the substrate and securing means leading region "can provide" a total composite Gurley stiffness within the claimed range (see page 38) and (3) "**[f]or example**, the securing means leading region 59 can provide for a peel removal force which is **greater or less** that the peel removal force provided for by the securing means trailing region 61" (page 39, emphasis added). Additionally, with respect to the peel removal force set forth in claims 14, 15, 33 and 34, the area of attachment of leading region of the fastener in the embodiment of Fig. 10 of Flug is illustrated as being significantly less than the attachment area of the fastener's trailing region. This being the case, there is a sound basis to conclude that in Flug the peel strength of the leading region is less than the trailing region as claimed.⁴

⁴ Where, as here, there is a sound basis to believe that the critical function for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art device (i.e., Flug), it is incumbent upon the appellants to prove that the device of Flug does not in fact possess the characteristics relied on. **See, e.g., In re Schreiber**, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997); **In re Spada**, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); **In re Ludtke**, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971) and **In re Swinehart**, 439 F.2d (continued...)

In view of the foregoing, we will sustain the rejections under 35 U.S.C. § 103 of (a) claims 1, 2, 4, 6-9, 11-15, 17-22, 25-35, 37 and 38 based on the combined teachings of Krushnel and Rossini and (b) claims 1, 2, 4, 6-15, 17-22, 25-35, 37 and 38 based on the combined teachings of Flug and Rossini.

Turning now to the rejections under 35 U.S.C. § 103 of claims 36 and 39-41 as being unpatentable over (a) Krushnel in view of Rossini and (b) Flug in view of Rossini, independent claims 36 and 39 each require that the fastener be attached to a separate elasticized side panel.⁵ We have carefully reviewed Krushnel, Rossini and Flug, but fail to find any teaching or suggestion of such an arrangement. This being the case, we will not sustain the rejections under 35 U.S.C. § 103 of claims 36 and 39-41 (a) based on the combined teachings of

⁴(...continued)
210, 212-13, 169 USPQ 226, 229 (CCPA 1971).

⁵ The answer fails to address the appellants' arguments that the relied on prior art fails to either teach or suggest this limitation.

Appeal No. 98-1314
Application No. 08/421,640

Krushnel and Rossini and (b) based on the combined teachings of Flug and Rossini.

In summary:

The rejections under 35 U.S.C. § 103 of (a) claims 1, 2, 4, 6-9, 11-15, 17-22, 25-35, 37 and 38 based on the combined teachings of Krushnel and Rossini and (b) claims 1, 2, 4, 6-15, 17-22, 25-35, 37 and 38 based on the combined teachings of Flug and Rossini are both affirmed.

The rejections under 35 U.S.C. § 103 of claims 36 and 39-41 (a) based on the combined teachings of Krushnel and Rossini and (b) based on the combined teachings of Flug and Rossini are both reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

Appeal No. 98-1314
Application No. 08/421,640

JAMES M. MEISTER)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
WILLIAM F. PATE, III)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

bae

Appeal No. 98-1314
Application No. 08/421,640

Paul Yee
Kimberly Clark Corporation
401 North Lake Street
Neenah, WI 54956